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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/788,606	02/27/2004	Mary E. Brunkow	601117-109	9642

22504 7590 09/21/2006

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EXAMINER

XIE, XIAOZHEN

ART UNIT PAPER NUMBER

1646

DATE MAILED: 09/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action Before the Filing of an Appeal Brief	Application No. 10/788,606	Applicant(s) BRUNKOW ET AL.	
	Examiner Xiaozhen Xie	Art Unit 1646	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 28 August 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 88-96.


Claim(s) withdrawn from consideration: 77-100.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.


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Continuation of 11. does NOT place the application in condition for allowance because: The rejection of claims 88-96 under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement and requirement, is maintained for reasons of record in the previous office actions. Applicant argues that the amended claim 88 reciting that the second polynucleotide comprises a nucleotide sequence that is fully complementary to SEQ ID NO: 1, 5, 9, 11, 13 or 15. Applicant argues that enablement in the present case is met by the provision of the starting polynucleotide sequences and methods of hybridizing other sequences and expressing the TGF- β binding protein, and one of skill would not require to make every single possible embodiment. Applicant's arguments have been fully considered but have not been found to be persuasive. The the claims still read on a genus, i.e. an isolated antibody or antigen binding fragment thereof which binds to a TGF- β binding protein, or fragments, variants thereof. While the specification discloses an isolated antibody or antigen binding fragment thereof which specifically binds to a TGF- β binding protein encoded by a polynucleotide that comprises SEQ ID Nos:1, 5, 9, 11, 13, and 15, one of skill has to evaluate any non-exemplified antibody for binding specificity.

The rejection of claims 88-96 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement, is maintained for reasons of record in the previous office action. Applicant argues that the class of polynucleotides encoding TGF- β binding protein can be easily determined based on provision of SEQ ID NO: 1, 5, 9, 11, 13 or 15, and applicant needs not disclose the chemical structures that would add "unnecessary bulk" to the application. Applicant's arguments have been fully considered but have not been found to be persuasive. Without the teachings that define any structural features commonly possessed by members of the genus that distinguish them from others, one skilled in the art cannot, as one can do with a fully described genus, recognize the identity of the members of the genus. A definition by function does not suffice to define the genus because it is only an indication of what property the protein has, rather than what it is.

The rejection of claims 88-96 under the judicially created doctrine of obviousness-type double patenting over claims 1-8 of U. S. Patent No: 6,803,453, is maintained. It is noted that Applicant indicated that a terminal disclaimer will be filed upon indication of allowable subject matter in this application.